Argument

In particular, the examiner asserts, in the response to arguments section of the present office action, that;

> as long as [a conclusion of obviousness based on hindsight reconstruction] takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

(Final Office Action, pages 4-5, citing In re McLaughlin, 443 F.2d 1392 (CCPA 1971))

Here, however, the examiner has failed to make the necessary showing regarding how the asserted obviousness conclusion is based on only that which was already known in the prior art, and not on impermissible hindsight gleaned from the applicant's own work. Controlling authority in regard to the obviousness inquiry cries out for *specificity*. (See, e.g., *In re Sang Su Lee,* 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)(citing *In re Kotzab,* 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed")).

Accordingly, without a specific showing, the examiner's conclusory statement that "modifying the polarizing member of Kishimoto by applying an optical rotator so that azimuthal rotation of linear polarization or of elliptical polarization is achieved" would have been obvious to one of ordinary skill in the art, does not adequately address the issue of motivation to combine. (*Lee* at 1443).

The examiner asserts that Kishimoto teaches a polarizing member with a cholesteric liquid crystal layer and a quarter-wave plate, as recited in claim 1. Further, the examiner recognizes that Kishimoto fails to disclose the claimed optical rotary layer but asserts that Itoh

teaches an optical rotator used for azimuthal rotation of linear polarization. The examiner, however, has not provided any evidence, void of hindsight reasoning, to support the conclusion that one of ordinary skill in the art would have been motivated to combine the independent features of Kishimoto and Itoh in the manner claimed. Accordingly, the §103 rejection of claim 1, and all claims dependent thereon, specifically, claims 2-11, is improper and should be withdrawn.

Additionally, on page 3 of the final office action, the examiner concludes that other claimed features are obvious as well. For example, with respect to claim 3, the examiner asserts that making the major or minor axes of the rotary layer parallel to a plane of polarization of light linearly polarized by a combination of the cholesteric liquid-crystal layer and the quarter-wave plate and to an axis of polarization of the absorption type polarizer would have been "obvious to a person skilled in the art from the point of view of the technical significance of providing an optically active layer." Again, however, the examiner provides no support whatsoever for this conclusion. In particular, the examiner points to nothing in the prior art references.

In regard to claims 5 and 6, the examiner asserts that "setting the condition for the degree of optical rotation of the optical rotary layer to be *satisfactory* does not constitute a special design restriction". The examiner, thus, concludes that claims 5 and 6 are obvious because "[t]he degree of optical rotation is such as can be decided in accordance with factors such as required performance traits." Once again the examiner has completely ignored the proper inquiry regarding *obviousness*. First, there is nothing in either Kishimoto or Itoh, or any other prior art of record, that even mentions a method for determining the degree of optical rotation based on

certain *required performance traits.* Thus, as discussed above, the examiner has failed to provide the specificity needed for a proper *prima facie* case of obviousness.

Additionally, in regard to claims 5 and 6, the examiner has ignored the specific language of the claims by over-generalizing them as merely requiring that the degree of optical rotation be selected to be "satisfactory". Claims 5 and 6 require more than a *satisfactory* degree of rotation. They each recite the specific requirement that the degree of rotation be chosen to equal $(2n+1)\pi/4$, where n is an integer. Accordingly, the examiner has not addressed the specific requirements of the claims and has not set forth a sufficient *prima facie* case of obviousness by pointing to a specific place in the prior art that discloses this requirement.

In regard to claims 7-10, the examiner has simply stated that the recited claim requirements are "common and known in the art and thus would have been obvious". As discussed above, this type of baseless conclusion is precisely what the courts have warned against.

Lastly, in regard to claim 11, the examiner simply concludes that since Itoh teaches an optical rotary layer for achieving rotation of polarization, and Kishimoto teaches a polarizing member with a cholesteric liquid crystal layer and a quarter-wave plate, "it would have been obvious ... that the modified structure [resulting from combining Itoh and Kishimoto] would have the quarter-wave plate in between the cholesteric liquid crystal layer and the optical rotary layer for achieving rotation of polarization." As with the other claims, discussed above, the examiner provides no support for this conclusion.

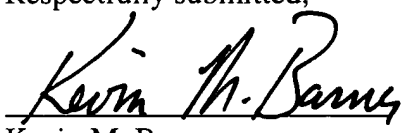
Accordingly, for all the reasons set forth above, the §103 rejection of claims 1-11 is improper and should be withdrawn.

Conclusion

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-11, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Since the USPTO was closed on December 25, and 26, 2003, this response is timely filed.